

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

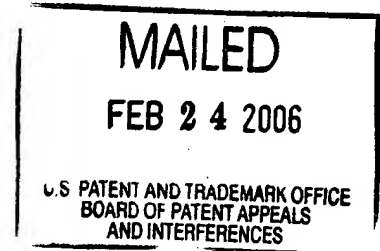
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MIKE G. ROEMMLER

Appeal No. 2005-2368
Application No. 09/802,707

ON BRIEF



Before KIMLIN, WARREN and JEFFREY T. SMITH, **Administrative Patent Judges**.
JEFFREY T. SMITH, **Administrative Patent Judge**.

ON REQUEST FOR REHEARING

Appellant has filed a paper under 37 CFR § 41.52 (a)(1)¹ requesting that we reconsider our decision of September 23, 2005.²

¹ Effective Sep. 13, 2004; 69 Fed. Reg. 49960 (Aug. 12, 2004); 1286 Off. Gaz. Pat. Office 21 (Sep. 7, 2004).

²Appellant's request submitted November 22, 2005.

37 CFR § 41.52 (a)(1) (2005) provides as follows:

Appellant may file a single request for rehearing within two months from the date of the original decision of the Board. No request for rehearing from a decision on rehearing will be permitted, unless the rehearing decision so modified the original decision as to become, in effect, a new decision, and the Board states that a second request for rehearing would be permitted. The request for rehearing must state with particularity the points believed to have been misapprehended or overlooked by the Board. Arguments not raised in the briefs before the Board and evidence not previously relied upon in the brief and any reply brief(s) are not permitted in the request for rehearing except as permitted by paragraphs (a)(2) and (a)(3) of this section. When a request for rehearing is made, the Board shall render a decision on the request for rehearing. The decision on the request for rehearing is deemed to incorporate the earlier opinion reflecting its decision for appeal, except for those portions specifically withdrawn on rehearing, and is final for the purpose of judicial review, except when noted otherwise in the decision on rehearing.

We have reconsidered our decision of September 23, 2005, in light of Appellant's comments in the request for rehearing, and we find no error therein. We, therefore, decline to make any changes in our prior decision for the reasons which follow.

Appellant asserts that the Board has misapprehended or overlooked the argument that Greinke, column 5, lines 38-47, suggests that there is an upper limit to the heat treatment since there is an undesirable fracturing

temperature. Specifically, Appellant argues that since Greinke states, "the second heat treatment should go between 600° and about 1000°C for a controlled time period with a longer hold time required for the 600°C. temperature and a shorter hold time required for the higher 1000°C. temperature." (Greinke, Col. 5, lines 50-54), the upper limit must be about 1000°C . Appellant further argues that Greinke also suggests that any temperature above 1000°C would be unacceptable since it will cause the stabilizing functional group to fracture. Appellant acknowledges that Greinke shows examples that have a maximum temperature of 1700°C but argues that these examples do not provide motivation to use temperatures of at least 1750°C due to the above argument that 1000°C is the highest allowable fracture temperature. (Request pp. 2-3).

These are essentially the same arguments Appellant presented in the Brief and Reply Brief. These arguments were addressed on pages 5 and 6 of our decision. As stated on page 5 of our decision,

Greinke discloses that the purification of expanded graphite occurs at a temperature above 600°C and exemplifies the temperature of 1700°C. Specifically, Greinke discloses that the second heat treatment is used to remove hydrophilic acid groups. (Col. 5, ll. 38-43). A person of ordinary skill in the art would have reasonably expected that graphite could have been purified at a temperature of 1750°C to remove hydrophilic acid groups. Moreover, in cases involving overlapping ranges, we and

our predecessor court have consistently held that even a slight overlap in range establishes a *prima facie* case of obviousness. *In re Geisler*, 116 F.3d 1465, 1469, 43 USPQ2d 1362, 1365 (Fed. Cir. 1997) (acknowledging that a claimed invention was rendered *prima facie* obvious by a prior art reference whose disclosed range (50-100 Angstroms) overlapped the claimed range (100-600 Angstroms)). We have also held that a *prima facie* case of obviousness exists when the claimed range and the prior art range do not overlap but are close enough such that one skilled in the art would have expected them to have the same properties. *Titanium Metals Corp. of Am. v. Banner*, 778 F.2d 775, 783, 227 USPQ 773, 779 (Fed. Cir. 1985). In light of that case law, we conclude that a *prima facie* case of obviousness was made out in this case.

Appellant argues that Greinke teaches away from using any temperature above 1000°C because it would be difficult to attain and would require increased cost. (Request, p. 3). As stated in our decision (restated above), Greinke discloses that purification of expanded graphite occurs at a temperature above 600°C and functions to remove hydrophillic acid groups. A person of ordinary skill in the art would have reasonably expected that graphite could have been purified at a temperature of 1750°C to remove hydrophillic acid groups.

Appellant further argues that Greinke teaches away from using any temperature above 1000°C because example 10 Greinke shows a temperature of 1200°C and the product produced was unsatisfactory due to

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blistering occurring after 90 days. This argument is not persuasive. Appellant's argument is premised on the comparative example 10 of Greinke. However, Greinke exemplifies products produced by heating to 1700°C. These products did not blister for over a year. (See examples 2 and 15).

In light of the foregoing and for the reasons expressed in our decision, it is our determination that the Examiner has established a *prima facie* case of obviousness with respect to the argued claims on appeal.


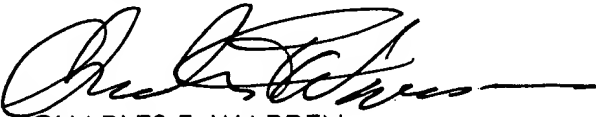

We have granted Appellant's request to the extent that we have reconsidered our decision of September 23, 2005, but we deny the request with respect to making any changes therein.

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Time for taking action

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(iv).

REHEARING REQUEST DENIED

)	
EDWARD C. KIMLIN)	
Administrative Patent Judge)	
)	
CHARLES F. WARREN)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS
)	AND
)	INTERFERENCES
JEFFREY T. SMITH)	
Administrative Patent Judge)	

JTS/tf

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